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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 April 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-24* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>19 January 2005</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Response to Amendment

This communication is responsive to the amendment filed on 04/30/2007.

Claims 1-13 are cancelled, and claims 14-24 are pending and have been examined.

However, examiner notes that 37 CFR 1.111(b) clearly states,

"The reply by the applicant or patent owner must be reduced to a writing which

distinctly and specifically points out the supposed errors in the examiner's action *and*

must reply to every ground of objection and rejection in the prior Office action."

(Emphasis added).

The amendment does, however, appear to a *bona fide* attempt to respond.

Accordingly, MPEP 714.03 recites,

"Where an amendment substantially responds to the rejections, objections, or

requirements in a non-final Office action (and is a *bona fide* attempt to advance the

application to final action) but contains a minor deficiency (e.g., fails to treat every

rejection, objection, or requirement), the examiner may simply act on the amendment

and issue a new (non-final or final) Office action. The new Office action may simply

reiterate the rejection, objection, or requirement not addressed by the amendment."

Therefore, examiner notes that the **objection to the drawings made on Page 3,**

Paragraph 2, and Page 4-5, Paragraph 3 were not responded to in the instant

amendment. The objection will be reiterated in the instant Office action.

Examiner also notes that applicant's arguments that were presented have been

carefully and respectfully considered by examiner, but they are not persuasive.

Accordingly, the Office action has been made **FINAL**.

Drawings

1. . The drawings are objected to under 37 CFR 1.83(a) because they fail to show:

1) "EF (Elementary File) of the user's card CAR" mentioned on page 4, line 20 as described in the specification. And,

2) "ADN file" mentioned on page 6, line 21 as described in the specification.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2.   The drawings are objected to because: On page 7 of the specification, lines 1-4,

applicant states a specific embodiment not shown in the drawings in which the following

step would be Step 3("In this case, the following step is Step 3"). Therefore, it follows

that Step 3 is not always the step that follows Step 2. In particular, case described on

lines 19-27 of the specification states Step 2 as a terminal step ("Then, in this case, the

synchronization process is finished"). However, drawings (Figure 2) show Step 3 always

following Step 2, which is inconsistent with the disclosure. Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary,

the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement

sheets may be necessary to show the renumbering of the remaining figures. Each

drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

3.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show

every feature of the invention specified in the claims. Therefore, the "storing a

synchronization object as a last synchronization object," "generating a new

synchronization object," "storing the new synchronization object," "reading the new

synchronization object," "comparing the new synchronization object," "modifying at least

one of the first and the second databases," "notifying the removable subscriber identity

module," "removable subscriber identity module provides the last synchronization object

and the new synchronization object," and etc. must be shown or the feature(s) canceled

from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next

Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. A series of singular dependent claims is permissible in which a dependent claim

refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any

claim which does not also depend from said dependent claim. It should be kept in mind

that a dependent claim may refer to any preceding independent claim. In general,

applicant's sequence will not be changed. See MPEP § 608.01(n). (*See e.g. claim 20*

that depends on claim 16, and is separated by claims 17-19 that do not depend on

claim 16)

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claim 22 is rejected under 35 U.S.C. 101 because it is directed towards

software, per se. The claims lack the necessary physical articles or objects to constitute

a machine or a manufacture within the meaning of 35 USC 101 (A system is purported

to comprise a database, a database can be implemented in software.). They are clearly

not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When <u>functional</u> descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming <u>non</u>functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim 23 is rejected under 35 U.S.C. 101 because it is directed towards software, per se. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101 (A computer readable medium comprises instruction, though no physical medium is claimed). They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory

category. They are, at best, functional descriptive material *per se*. Descriptive material

can be characterized as either "functional descriptive material" or "nonfunctional

descriptive material." Both types of "descriptive material" are nonstatutory when

claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When

functional descriptive material is recorded on some computer-readable medium, it

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most cases since use of technology permits the function of the descriptive material to be

realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed.

Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas,

stored on a computer-readable medium, in a computer, or on an electromagnetic carrier

signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8

(noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas

because "[t]he sole practical application of the algorithm was in connection with the

programming of a general purpose computer.").

Any claim not specifically addressed above, is being rejected as incorporating the

deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

7.   **Claims 19 and 20** are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

Regarding claim 19, applicant claims: "new synchronization object is used to

detect modifications to the first database after the last synchronization."

Regarding claim 20, applicant claims: "the new synchronization object is used to

detect any new modifications performed after the last synchronization."

However, on page 4 of the specification, lines 20 -24 applicant attributes this

functionality to the smartcard. Further, on page 5, lines 20-26 applicant states, "the

smartcard CAR will replace the last synchronization object by the new one, and will be

henceforth able to detect further modifications in the database DB1." Similarly on page

7, lines 21-22 applicant states, "once this command is performed, the smartcard will be

able to detect changes henceforward performed." See also page 7, line 25.

It is therefore believed by the examiner that specification describes removable

card CAR as being able to detect further modification by reading synchronization

objects. Application does not enable one skilled in the pertinent art to grasp how

synchronization object can be able to detect its own modification.

8.   **Claims 14-24** are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.   All claims refer to the "synchronization object". Synchronization object as such is not enabled by the disclosure.

Regarding **claim 14**, synchronization object is claimed to "define the state of the first database before any modification to the first database are made after the first synchronization". Because synchronization object or an exemplary embodiment thereof is not described in the specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

Regarding **claim 15**, comparison of synchronization objects to indicate the previous synchronizations is claimed. Because synchronization object or an exemplary embodiment thereof is not described in the specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

Regarding **claim 19**, synchronization object is claimed to detect modifications. Because synchronization object or an exemplary embodiment thereof is not described in the specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

Regarding **claim 20**, synchronization object is claimed to detect new modifications to the first database after the first synchronization. Because synchronization object or an exemplary embodiment thereof is not described in the

specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

Regarding **claim 21**, synchronization object is claimed to indicate a state of the first database before any modifications are made. Because synchronization object or an exemplary embodiment thereof is not described in the specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

Regarding **claim 22 and 24**, synchronization object is claimed to indicate the last synchronization between the first and the second database. Because synchronization object or an exemplary embodiment thereof is not described in the specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

Regarding **claim 23**, synchronization object is claimed to define a last synchronization performed between the first and the second database. Because synchronization object or an exemplary embodiment thereof is not described in the specification, a person having ordinary skill in the pertinent art without undue experimentation would not be enabled to make or use the invention as claimed.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claim 17 recites the limitation "a program" in line 1. There is insufficient antecedent basis for this limitation in the claim.

11.   Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Following claim language renders the claim indefinite: "A system configured to

communicate with a removable device comprising a first database, the removable

device comprising:"

It is not clear what a removable device is comprising of: "a first database" or "a

program".

It is also not clear if it is "a system" or "a removable device" that comprises the

first database.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 14-16, and 21-24 are rejected under 35 U.S.C. 102(e) as being

anticipated by Novak et al., US Patent Application Publication No. US 2003/0037020 A1

(Hereinafter "Novak et al.").

Regarding **claim 14**, Novak et al. shows:

A method for synchronizing a first database with a second database in a system

comprising: (Abs)

Storing a synchronization object (*checksum, [0030]*) as a last synchronization

object associated with the first database in a memory of a removable subscriber identity

module (*Fig 2 #50*) after a first synchronization of the first and second database (*"The*

calculated checksum can then be stored and used to aid in tracking changes to the

database stored in the memory 180, e.g., a SIM card." See e.g., [0030]), wherein the

last synchronization object indicates a state of the first database before any

modifications to the first database are made after the first synchronization (*Use of*

checksum in synchronization, see e.g. [0032], "checksum associated with contents of

the database," see e.g. [0033]);

Generating a new synchronization object associated with the first database when

the removable subscriber identity module receives a request for a new synchronization

(*"However, the checksum can be calculated and stored in the device as the DID at other*

times. Examples include: when a receiving device requests the change log or DID for

purposes of synchronization," see e.g. [0031]); and

Storing the new synchronization object in the memory of the removable

subscriber identity module (*"The calculated checksum can then be stored and used to*

aid in tracking changes to the database stored in the memory 180, e.g., a SIM card."

See e.g., [0030], [0032]),

Wherein the system comprises a plurality of devices (*"the present invention finds*

particular application to the synchronization of databases between devices wherein at

least one of the devices has a removable SIM card, e.g., a mobile phone," see e.g.

[0022]);

Wherein the first database is stored in the removable subscriber identity module;

("The calculated checksum can then be stored and used to aid in tracking changes to

the database stored in the memory 180, e.g., a SIM card." See e.g., [0030], Fig 2 #50)

Wherein the second database is stored in at least one device from the plurality of

devices in the system, *(See e.g. Fig 2 #40)* and

Wherein the removable subscriber identity module is configured to communicate

with at least one device from the plurality of devices in the system. *(See e.g. SIM*

communicating with mobile device Fig 2, mobile device communicating with SIM card

Fig 6A) ·

Regarding **claim 15**, Novak et al. shows:

Reading the new synchronization object associated with the first database when

the new synchronization is requested between the first and the second database; *(See*

e.g., [0032], Fig 6B)

Comparing the new synchronization object associated with the first database with

a synchronization object associated with the second database; *(See e.g., [0032], Fig*

6B) and

Modifying at least one of the first and the second databases to synchronize the

first database with the second database when a comparison between the new

synchronization object associated with the first database and the synchronization object

associated with the second database indicates that the first and the second database

have been previously synchronized and modifications have occurred since the previous

synchronization. (*See e.g., [0032], Fig 6B*)

Regarding **claim 16**, Novak et al. shows:

Notifying the removable subscriber identity module when the new

synchronization is initiated between the first database and the second database,

(*requesting DID for purposes of synchronization, see e.g. [0031]*)

Wherein the removable subscriber identity module provides the last

synchronization object and the new synchronization object; (*calculating checksum*

before synchronization and after, see e.g. [0031]) and

Wherein the new synchronization object is stored as the last synchronization

object after the successful completion of the new synchronization of the first database

with the second database. (*Recalculating checksum and replacing DID with it, see e.g.*

[0031] and [0032])

Regarding **claim 21**, Novak et al. shows:

A system comprising:

A plurality of devices, wherein at least one device from the plurality of devices is

a removable subscriber identity module; (*"the present invention finds particular*

application to the synchronization of databases between devices wherein at least one of

the devices has a removable SIM card, e.g., a mobile phone," see e.g. [0022]);

Wherein the removable subscriber identity module is configured to communicate

with at least another device from the plurality of devices and adapted to comprise a first

database; (*See e.g. SIM communicating with mobile device Fig 2, mobile device communicating with SIM card Fig 6A*) and

Wherein at least one device from the plurality of devices is adapted to comprise a second database; (*See e.g. Fig 2 #40*) and

Wherein the removable subscriber identity module comprises,

A memory (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030]*),

A synchronization object stored as a last synchronization object associated with the first database in the memory after a first synchronization of the first and the second database; (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030]*) and

A new synchronization object associated with the first database stored in the memory when the removable subscriber identity module receives a request for a second synchronization (*"However, the checksum can be calculated and stored in the device as the DID at other times. Examples include: when a receiving device requests the change log or DID for purposes of synchronization," see e.g. [0031]*);

Wherein the last synchronization object indicates a state of the first database before any modifications are made to the first database after the first synchronization. (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*);

Regarding **claim 22**, Novak et al. shows:

A system configured to communicate with a removable device comprising a first database, the removable device comprising:

A program for generating a synchronization object each time a synchronization is initiated between the first database and a second database (*"However, the checksum can be calculated and stored in the device as the DID at other times. Examples include: when a receiving device requests the change log or DID for purposes of synchronization," see e.g. [0031]*);

Wherein the synchronization object is associated with the first database; (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030]*)

Wherein the synchronization object is associated with the second database upon successful synchronization between the first and the second database; (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*); and

Wherein the synchronization object indicates the last synchronization between the first and the second database. (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*);

Regarding **claim 23**, Novak et al. shows:

A computer readable medium comprising instructions to execute a program configured to facilitate communication with a removable device, comprising:

Instructions for sending a command to the removable device for setting a synchronization object associated with a first database, the first database being stored in the removable device (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030], Use of checksum in synchronization, see e.g. [0032]*,)

Wherein after a synchronization is initiated between the first database and a second database stored in an external device, the synchronization object is also associated with the second database after successful synchronization of the first and the second database; (*Use of checksum in synchronization, see e.g. [0032]*) and

Wherein after the successful synchronization is performed, the synchronization object now defines a last synchronization performed between the first and the second database to be used for a second synchronization between the first and the second database. (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*)

Regarding **claim 24**, Novak et al. shows:

Instructions for receiving a command for setting a synchronization object from an external device; (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*)

Instructions for executing the command and generating the synchronization object associated with a first database stored in the removable device; (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*)

Wherein the synchronization object is associated with a second database stored

in an external device after a synchronization between the first and the second database

is successfully performed; (*Use of checksum in synchronization, see e.g. [0032],*

"checksum associated with contents of the database," see e.g. [0033]) and

Wherein the synchronization object indicates the last synchronization between

the first and the second database. (*Use of checksum in synchronization, see e.g.*

[0032], "checksum associated with contents of the database," see e.g. [0033])

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

15.   **Claims 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Novak et al. in view of Ahlgren et al. US Patent No. 6968209 B1 (Hereinafter

"Ahlgren et al.").

Regarding **claim 17,** as well as understood, as set forth in the rejection of claim

14 above, Novak et al. shows all the claimed limitations except, it does not expressly

disclose that a removable device can be asked for its modifications.

However, Ahlgren et al. teaches that changes between change log stored on the

device and changes made in SIM card can be synchronized (Col 4, line 55 – Col 5, line

11).

Novak et al. and Ahlgren et al. are analogous art because they are from the
same field of endeavor of synchronizing SIM card with a database.

It would have been obvious to one having ordinary skill in the art at the time the
invention was made to synchronize the device of Novak et al. with the SIM card of
Novak et al. in order to speed up the synchronization, as taught by Ahlgren et al.

Motivation of doing so would be to enhance the synchronization (See e.g. using
checksum to enhance database synchronization, Ahlgren et al., Col 4, lines 55-58) ·

Regarding **claim 18**, as set forth in the rejection of claim 17 above, Novak et al.
shows all the claimed limitations except, it does not expressly disclose that the device is
able to make use of a local copy of the removable device memory.

However, Ahlgren et al. teaches that the device is able to make use of a local
copy of the removable device memory (Col 4, lines 24-29, checksum is stored both in
the SIM and phone) to obtain the database content and to follow with the data
synchronization process.

Novak et al. and Ahlgren et al. are analogous art because they are from the
same field of endeavor of synchronizing SIM card with a database.

It would have been obvious to one having ordinary skill in the art at the time the
invention was made to store information on the device of Novak et al. and in the SIM
card of Novak et al. in order to speed up the synchronization, as taught by Ahlgren et al.

Motivation of doing so would be to speed up the synchronization (See e.g. "Thus,
the synchronization process may be performed more rapidly," Ahlgren et al., Col 2, lines
29-30)

16.   **Claims 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Novak et al., in view of Applicants' Admitted Prior Art in the original disclosure

(Hereinafter "AAPA").

Regarding **claims 19 and 20,** Novak et al. teaches all the limitations of claim 3

(See use of Novak et al. in rejection of claims 14 and 16 above) except, it does not

expressly disclose device informing the removable device that the synchronization has

been successfully performed.

However, AAPA discloses that it is known for both systems to exchange

acknowledgment and finalization messages. (*See e.g., page 2, lines 12-13 of the*

specification in original disclosure)

It would have been obvious to one having ordinary skill in the pertinent art at the

time the invention was made that device of Novak et al. can inform the removable

device of Novak et al. the success of the synchronization as taught by AAPA.

Motivation to do so would be to let the removable device know so it can

recalculate the checksum and replace the old checksum by the new one.

Response to Arguments

Drawings

17.   Applicant's arguments with regard to objections to drawings have been fully

considered but they are not persuasive.

Applicant states: "The drawings were objected to for failing to show every feature

of the invention specified in the claims." (See page 11 of remarks)

The drawings were, however, objected to three times. Specifically:

a.   On page 2 of the office action mailed on January 29, 2007, (Paragraph 1)

drawings were indeed objected to for failing to show every feature of the

invention specified in the claims.

b.   On page 3-4 of the office action mailed on January 29, 2007, (Paragraph

2) drawings were objected to for failing to show structural detail that is essential

for a proper understanding for disclosed invention.

c.   On page 4-5 of the office action mailed on January 29, 2007, (Paragraph

3) drawings were objected to for failing to show structural detail that is essential

for a proper understanding for disclosed invention.

Applicant argues that: "However, 37 CFR § 1.83(a), as cited by the Examiner,

specifically requires that any structural detail that is essential for a proper understanding

of the disclosed invention should be shown in the drawing. (See Office Action mailed on

January 29, 2007, p. 3). Said another way, 37 CFR § 1.83(a) does not require every

element referred to in the claims be shown."

Examiner respectfully disagrees, and notes that there is a difference between

disclosed and claimed invention.

The following is a quotation of the 37 CFR § 1.83(a):

> (a) **The drawing in a nonprovisional application must show every**
>
> **feature of the invention specified in the claims.** However, conventional
>
> features disclosed in the description and claims, where their detailed
>
> illustration is not essential for a proper understanding of the invention,

should be illustrated in the drawing in the form of a graphical drawing

symbol or a labeled representation (e.g., a labeled rectangular box). In

addition, tables and sequence listings that are included in the specification

are, except for applications filed under 35 U.S.C. 371, not permitted to be

included in the drawings.

The following is a quotation from the MPEP § 608.02(d), which was cited in the

office action mailed on January 29, 2007, page 3, ("Any structural detail that is essential

for a proper understanding of the disclosed invention should be shown in the drawing.

MPEP § 608.02(d)."):

Any structural detail that is of sufficient importance to be described should

be shown in the drawing. (*Ex parte Good*, 1911 C.D. 43, 164 O.G. 739

(Comm'r Pat. 1911).)

Therefore, 37 CFR § 1.83(a), indeed requires every element referred to in the

claims be shown. Further, according to MPEP § 608.02(d), any structural detail that is

essential for a proper understanding of the disclosed invention should be shown in the

drawing.

Claims

18.   Applicant's arguments with respect to claims have been considered but are moot

in view of the new ground(s) of rejection.

Following arguments are still relevant to references being applied:

19.   Applicant argues that "cited references fail to disclose, teach, or suggest storing

a synchronization object associated with the first database in a memory of a removable

subscriber identity module that indicates a state of the first database before any further

modifications to the first database are performed." Applicant further argues that "the

Applicant respectfully asserts that the memory 180, as shown in Figure 4 of Novak, is

part of the mobile phone memory (i.e., not located in the SIM card). Said another way,

Novak discloses that the checksum is calculated and stored outside of the SIM card.

Thus, Novak is completely silent with respect to a removable subscriber identity module

that may be configured to generate a synchronization object inside the removable

subscriber identity module."

Applicant, however, quotes a sentence from Novak incompletely to support his

argument. The following is a full sentence quotation from Novak, paragraph [0030]:

The calculated checksum can then be stored and used to aid in tracking changes

to the database stored in the memory 180, e.g., a **SIM card.** (Emphasis added.)

Further, Novak also teaches: "Moreover, memory 180 can be a removable

memory structure, such as a smart card, SIM card, etc." ([0026])

As can be clearly seen from the quotations above checksum can indeed be

stored in a SIM (subscriber identity module) card.

20.   Applicant further argues that "while Ahlgren discussed synchronization of

databases (see, e.g., Ahlgren, Figure 2), there is no mention in Ahlgren that any data

associated with the synchronization (e.g., a synchronization object) could be stored

inside the SIM card. In fact, Ahlgren, as evidenced by the following, specifically teaches away from storing a synchronization object inside the SIM card."

Unfortunately, although this improves the synchronization process, adding the change logs introduces another problem. Since memory on the SIM card 50 is limited, it is likely that the change log will be stored in another memory device in the mobile phone 20, e.g., local RAM (not shown), rather than on the SIM card 50 itself, as is the database. (Ahlgren, col 2, ii 31-36)."

As can be seen from the paragraph quoted above, Ahlgren indeed mentions that the data associated with synchronization (change log) can be stored inside the SIM card, and that it can even improve the synchronization process. Ahlgren, in alternative, also teaches that such logs can be stored in another memory rather than on the SIM card itself. Therefore, Ahlgren indeed teaches that it is possible to store change logs inside the SIM card, and doing so would improve synchronization process. See MPEP § 2123.

Further, Ahlgren teaches storing synchronization object (phonebook identifier and/or a user identifier fields) inside the SIM card as an alternative to storing change log. (See e.g. Col 3, lines 14-21)

Conclusion

21.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Aleksandr Kerzhner whose telephone number is (571)

270-1760. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00

p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Pierre Vital can be reached on (571) 272-4215. The fax phone number for

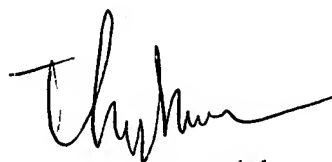the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.K.,
05/21/2007
AK

THOMAS PHAM
PRIMARY EXAMINER